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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/589,413

08/15/2006

John Y. Lee

OR-7244 US

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PATENT DEPARTMENT  
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EXAMINER

NWAONICHA, CHUKWUMA O

ART UNIT

PAPER NUMBER

1621

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DELIVERY MODE

12/18/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No. 10/589,413	Applicant(s) LEE ET AL.	
	Examiner CHUKWUMA O. NWAONICHA	Art Unit 1621	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 August 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5, 7, 9, 11-14, 16, 18, 21, 24, 29, 30, 34, 37, 51, 54, 56, 58, 59 and 62 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5, 7, 9, 11-14, 16, 18, 21, 24, 29, 30, 34, 37, 51, 54, 56, 58, 59 and 62-56 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Current Status***

1. This action is responsive to Applicants' amendment of 22 August 2008.
2. Receipt and entry of Applicants' amendment is acknowledged.
3. Claims 1-3, 5, 7, 9, 11-14, 16, 18, 21, 24, 29, 30, 34, 37, 51, 54, 56, 58, 59 and 62-56 are pending in the application.
4. The rejection of claims 1-3, 5, 7, 9, 11-14, 16, 18, 21, 24, 29, 30, 34, 37, 51, 54, 56, 58 and 59 under 35 U.S.C. 103 as being unpatentable over Rosen et al., {US 5,919,983} is withdrawn because the prior art reference does not teach all the claim limitations.
5. The rejection of claims 1-3, 5, 7, 9, 11-14, 16, 18, 21, 24, 29, 30, 34, 37, 51, 54, 56, 58 and 59 under 35 U.S.C. 103 as being unpatentable over Lee et al., {US 6,162,950} and Lee, {US 6,169,208} is withdrawn in favor of a new rejection.
6. The rejection of claims 1-3, 5, 7, 9, 11-14, 16, 18, 21, 24, 29, 30, 34, 37, 51, 54, 56, 58 and 59 under 35 U.S.C. 103 as being unpatentable over Lee, {US 6,388,138} for the reasons set forth in the previous Office Action of 05/23/2008 is maintained.

Applicants' argument and amendments filed 22 August 2008 have been fully considered but they are not persuasive because Applicants claimed process is obvious in view of the prior art references cited. Applicants' argument is based on the fact that the prior art employed different concentration of ammonium salt and the product yield. Additionally, Applicants argue that their process yield unexpected result. From the results depicted in the prior art references cited the difference between Applicants

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product yield and that of the prior arts is insignificant to constitute a patentable distinction. Merely modifying the process conditions such as **concentration** is not a patentable modification absent a showing of criticality. In re Aller, 220 F.2d 454, 105 U. S. P. Q. 233 (C. C. P. A. 1955). Applicants have not shown any significant improvement in their process as opposed to the prior arts process. Applicants failed to provide a side-by-side comparison of their process and that of the prior arts process. The submission of this data would make Applicants' argument convincing.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

**Claim** 1-3, 5, 7, 9, 11-14, 16, 18, 21, 24, 29, 30, 34, 37, 51, 54, 56, 58, 59 and 62-56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee , {US 6,388,138}.

Applicants' claim a process for producing at least one protic ammonium tetrakis(<sup>F</sup>aryl)borate; wherein all the other variables are as defined in the claims.

**Determination of the scope and content of the prior art (M.P.E.P. §2141.01)**

Lee teaches a method for producing in at least one protic ammonium tetrakis(<sup>F</sup>aryl)borate from at least one tetrakis(<sup>F</sup>aryl)borate salt in an organic solvent in the presence of an amine and a protic acid to give 92% yield, Example 2. See column 5, lines 46-54, and examples 1, 2 and 9.

**Ascertainment of the difference between the prior art and the claims (M.P.E.P.. §2141.02)**

Lee process for producing at least one protic ammonium tetrakis(<sup>F</sup>aryl)borate differs from the instantly claimed process in that Applicants' claim process is narrower in scope than the teaching of the prior arts references. Specifically, Applicants' claim a process that employs at least one alkali metal tetrakis(<sup>F</sup>aryl)borate, at least one magnesium tetrakis(<sup>F</sup>aryl)borate, at least one halomagnesium tetrakis(<sup>F</sup>aryl)borate, or a mixture of two or more of the foregoing while the prior arts teach a process that employed tetrakis(<sup>F</sup>aryl)borate salts.

**Finding of prima facie obviousness--rational and motivation (M.P.E.P.. §2142-2143)**

The instant claimed process for producing a protic ammonium tetrakis(<sup>F</sup>aryl)borate is obvious over the prior art reference of Lee because the reference teaches a process of employing at least one alkali metal tetrakis(<sup>F</sup>aryl)borate, at least

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one magnesium tetrakis(<sup>F</sup>aryl)borate to make a protic ammonium tetrakis(<sup>F</sup>aryl)borate compound.

One of ordinary skill in the art would have a reasonable expectation of success in practicing the instant invention by following the process steps and conditions taught by Lee to arrive at the instantly claimed process for making protic ammonium tetrakis(<sup>F</sup>aryl)borate. Said person would have been motivated to practice the teaching of the reference cited because it demonstrates that protic ammonium tetrakis(<sup>F</sup>aryl)borate which, can be made in an organic solvent have industrial applications. Thus, the variation of the process conditions in the production of protic ammonium tetrakis(<sup>F</sup>aryl)borate is not a patentable distinction because Lee teaches the elements of the claimed invention with sufficient guidance, particularity, and with a reasonable expectation of success, that the invention would be *prima facie* obvious to one of ordinary skill in the art.

Additionally, simply reversing the order of steps in a multi-step process is not a patentable modification absent unexpected or unobvious results. Ex parte Rubin, 128 U.S.P.Q. 440 (P.O.B.A 1959). Additionally, merely modifying the process conditions such as **concentration** is not a patentable modification absent a showing of criticality. In re Aller, 220 F.2d 454, 105 U. S. P. Q. 233 (C. C. P. A. 1955).

Moreover, all the claimed elements (alkali metal tetrakis(<sup>F</sup>aryl)borate, magnesium tetrakis(<sup>F</sup>aryl)borate, halomagnesium tetrakis(<sup>F</sup>aryl)borate, an organic solvent, amine and a protic acid for making protic ammonium tetrakis(<sup>F</sup>aryl)borate) were known in the prior art references cited and one skilled in the art could have combined the elements

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as claimed by known methods with no change in their respective functions, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-3, 5, 7, 9, 11-14, 16, 18, 21, 24, 29, 30, 34, 37, 51, 54, 56, 58, 59 and 62-56 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 17-49 of US 6,162,950 and claims 1-62 of US 6,169,208. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the patents, each taken individually, disclose a method for the synthesis of a protic ammonium tetrakis(<sup>F</sup>aryl)borate that further include the use of alkali metal tetrakis(<sup>F</sup>aryl)borate, magnesium tetrakis(<sup>F</sup>aryl)borate, halomagnesium tetrakis(<sup>F</sup>aryl)borate, an organic solvent, amine and a protic acid as defined by applicants' claims differing in specifics of arrangement to a degree that would have been obvious for one having ordinary skill in the art to form

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the purpose of achieving acceptable synthesis of a protic ammonium tetrakis(<sup>F</sup>aryl)borate in order to arrive at the process of applicants' claims with the expectation of success in the absence of a showing of new or unexpected result.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chukwuma O. Nwaonicha whose telephone number is 571-272-2908. The examiner can normally be reached on Monday thru Friday, 8:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel Sullivan can be reached on 571-272-0779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Chukwuma O. Nwaonicha/  
Examiner, Art Unit 1621

/Sikarl A. Witherspoon/  
Primary Examiner, Art Unit 1621

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Daniel Sullivan  
Supervisory Patent Examiner,



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